UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,474	09/08/1998	EIJI TAKASU		3424

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No. 09/148,474

Applicant(s)
TAKASU ET AL.

Examiner
CESAR B PAULA

Art Unit
2178

Office Action Summary

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04 August 2003_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-31_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-31_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to the RCE filed on 8/4/2003.

This action is made Non-Final.

2. In the amendment, claims 1-31 are pending in the case. Claims 1, 10, 14, 26, and 30-31 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 9-243,991 filed in Japan on 9/9/1997, which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher view of Linking Handwriting Annotation with Text, IBM TDB, vol.32, No.6A, pp.452-454, 11/1989, and further in view of Forcier (Pat. # 5,590,257, 12/31/96).

Regarding independent claim 1, Mosher discloses: *storing a received mail document --*

"You can save messages ......" (p.1). Mosher fails to explicitly teach *ink data overlaid on a text*

image...a reproduction position of the ink image being defined by a coordinate value on

reference coordinate axes of the received mail document. However, IBM teaches the overlaying

of ink over text data (p.1, and fig.1). Forcier teaches the definition, or identification of ink image

text in terms of relative, and actual X, Y, document coordinates which are stored in the document

(c.21,L.31-67). It would have been obvious to one of ordinary skill in the art at the time of the

invention to have combined the email system of Mosher, the overlaying of ink data and text data

of IBM, and Forcier, because IBM teaches preserving the correspondence between text and ink

annotation (p.1,L.10-14); this would provide the advantage of ensuring that the text and ink

annotations stay together even when a copy of a move of this data takes place. Forcier teaches

above the anchoring of ink data.

Moreover, Mosher discloses: inserting a character string to email text data when a new

email is prepared --"Figure 12.9 When you reply to a message....indenting the message text and

including header " (p.4, and 7). Mosher fails to explicitly teach *calculating a coordinate shift*

amount of the reproduction position of the ink image. However, Forcier teaches pushing or

shifting down of data, consisting of text/ink image, based on the input of preceding document

data (c.10,L.35-c.11,L.67). It would have been obvious to one of ordinary skill in the art at the

time of the invention to have combined the email system of Mosher, and Forcier, because Forcier

teaches above ensuring that data stays together, and the benefit of providing an appropriate shift

of the data as a unit.

Moreover, Mosher discloses: inserting a character string to email text data when a new email is prepared --"Figure 12.9 When you reply to a message....indenting the message text and including header " (p.4, and 7). Mosher fails to explicitly teach *outputting, as the new document, the ink image which is overlaid on the new text image ...the reproduction position of the ink image being shifted according to the calculated coordinate shift amount.* However, IBM teaches the moving text and handwritten together by a predetermined shift amount (p.1, lines 10-29). Forcier teaches pushing or shifting down of data, consisting of text/ink image, based on the input of preceding document data (c.10,L.35-c.11,L.67, c.21,L.31-67).   It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, the overlaying of ink data and text data of IBM, and Forcier, because IBM teaches preserving the correspondence between text and ink annotation (p.1,L.10-14); this would provide the advantage of ensuring that the text and ink annotations stay together even when a copy of a move of this data takes place. Forcier teaches above the anchoring of ink data, so as to ensure that the data stays together.

Regarding claim 2, which depends on claim 1, Mosher discloses: "Figure 12.9 When you reply to a message....indenting the message text and including header " (p.4). Mosher fails to explicitly teach *the ink data comprises locus information to define the output position by coordinate values.* However, IBM teaches the moving text and handwritten together by a predetermined shift amount (p.1, lines 10-29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined shifting of email messages by Mosher, and the locus information of ink/ASCII editing system by moving/shifting **(locus x-y**

placement of ink data), and maintaining the pre-existing word spacing in the characters as

taught by IBM, because IBM teaches preserving the correspondence between text and ink

annotation (p.1,L.10-14).

Regarding claim 3, which depends on claim 1, Mosher discloses: "...how much text of

the incoming message to quote ......" (p.3). Mosher fails to explicitly disclose: ....*said character*

string to be inserted is a quotation symbol. However, it would have been obvious to a person of

ordinary skill in the art at the time of the invention to have included the quotation symbol,

because Mosher teaches above, quoting text in a reply email message.

Regarding claim 4, which depends on claim 1, Mosher discloses: "...how much text of

the incoming message to quote" (p.3). Mosher fails to explicitly teach *said character string to be*

inserted is an inserting comment text. However, Forcier teaches: "performing word editing

functions such as word wrap while maintaining the user's word spacing", and "Typical users of

the invention would be people who want to jot down notes with/without drawings" (col. 3, lines

3-67, and col. 5, lines 27-67). It would have been obvious to one of ordinary skill in the art at

the time of the invention to have combined shifting of email messages by Mosher, and the jotting

notes with ink/ASCII editing system to maintain word spacing taught by Forcier, because Forcier

teaches above the entering of data into a textual document without having to perform explicit

actions to acquire additional blank spaces, and quickly annotating a document.

Claims 5-9 are directed towards a method for implementing the steps found in claim 1, 1, 6, and are similarly rejected.

Claims 10-11 are directed towards a method for implementing the steps found in claims 1-2, and 1 respectively (where the ink data of claim 1 is equivalent to the locus information of claim 10), and are similarly rejected.

Claims 12-15, 17-22 are directed towards an information processing apparatus for implementing the steps found in claims (1-2), 2, and 1-2, and 4-9 respectively, and are similarly rejected.

Claim 16 is directed towards an information processing apparatus for implementing the steps found in claim 3, and is similarly rejected.

Regarding claim 23, which depends on claim 14, Mosher discloses: *output means is an inkjet printer--* (p.9). Mosher teaches use of a print file icon to print the email in a printer such as an inkjet printer.

Claims 24-29 are directed towards an information processing apparatus for implementing the steps found in claims 23, 1, 10-13 respectively, and are similarly rejected.

Claims 30-31 are directed towards a storage medium for storing instructions for

implementing the steps found in claims 1, and 10 respectively, and are similarly rejected.

Response to Arguments

6.   Applicant's arguments filed 8/4/03 have been fully considered but they are not

persuasive. The Applicants remark that the applied art does not disclose or suggest the

calculation of a coordinate shift amount as well as an output image (locus image)overlaid on a

text image at a position shifted according to the calculated amount (p.12, L. 20-p.13, L.2). The

Examiner disagrees, because although, Mosher fails to explicitly teach *outputting, as the new*

document, the ink image which is overlaid on the new text image ...the reproduction position of

the ink image being shifted according to the calculated coordinate shift amount. However, IBM

teaches the moving text and handwritten together by a predetermined shift amount (p.1, lines 10-

29). Forcier teaches pushing or shifting down of data, consisting of text/ink image, based on the

input of preceding document data, and teaches the definition, or identification of ink image text

in terms of relative, and actual X, Y, document coordinates which are stored in the document

(c.10,L.35-c.11,L.67, c.21,L.31-67).   It would have been obvious to one of ordinary skill in the

art at the time of the invention to have combined the email system of Mosher, the overlaying of

ink data and text data of IBM, and Forcier, because IBM teaches preserving the correspondence

between text and ink annotation (p.1,L.10-14), and Forcier teaches above ensuring that data stays

together.

Moreover, The Applicants remark that forcier does not teach reproducing ink data overlaid on a text image at a reproduction position defined by a coordinate value shifted by a calculated coordinate shift amount (p.13, L. 10-p.14, L.2). The Examiner disagrees, because IBM teaches the moving handwritten overlaid on text together by a predetermined shift amount (p.1, lines 10-29). Forcier teaches pushing or shifting down of data, consisting of text/ink image, based on the input of preceding document data, and teaches the definition, or identification of ink image text in terms of relative, and actual X, Y, document coordinates which are stored in the document (c.10,L.35-c.11,L.67, c.21,L.31-67). The amount of shifted space is calculated based upon coordinates.

Conclusion

I.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- **(703) 703-872-9306,** (for **all** Formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CESAR B PAULA
Patent Examiner
Art Unit 2178

10/20/03